

REMARKS

Claims 1-20 are currently pending in the application. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

35 U.S.C. § 112, second paragraph, Rejection

Claims 1-3, 8-11 and 16 were rejected under 35 U.S.C. § 112, second paragraph, for being allegedly indefinite.

The Examiner asserts that claim 2 is indefinite because “it is unclear what is the association and/or relationship between the web page and the email.” Applicants respectfully disagree with this assertion of indefiniteness.

There is no requirement under 35 U.S.C. § 112, second paragraph, that each recited feature of a claim have an association or relationship to another recited feature. Nor has the Examiner cited any basis in law for such an assertion. Moreover, even if the Examiner were correct, the Examiner would have to ignore the clear language of claim 2 to make such an assertion because claim 2 in fact recites receiving a web page navigation associated with the email. Thus, the Examiner’s assertion is without legal basis and contradicted by the very claim language asserted to be indefinite.

Furthermore, Applicants submit that contrary to the Examiner’s assertions, Applicants are not required under section 112, 2nd paragraph, to limit the invention to any particular cooperative relationship between the recited steps. To the extent that the Examiner relies upon MPEP 2172.01, the Examiner has misread MPEP 2172.01, which indicates that when it is indicated “by applicant” in the specification that certain features are essential to the invention, such features must be recited in the claims. The

Examiner has identified no features which were indicated "by Applicant" to be critical and which are not recited in the claims.

The Examiner asserts that claims 1-3, 8-11 and 16 are indefinite because "it is unclear what is a preferred viewing order." Applicants respectfully disagree with this assertion of indefiniteness.

Applicants note that the specification clearly and specifically explains what is meant by the language asserted to be indefinite (see paragraph [0020] of the instant published application No. 2002/0147779). Applicants note, for example, that the language "preferred viewing order" relates to a viewing order that is defined by the originator and which informs the recipient that the URLs provided in the email should be viewed in a particular order designated by the originator. The term "preferred" is not being used in the way typically found to be objectionable under current USPTO rules, such as when it is used to designate alternative features and/or both broad and narrow definitions of the same recited feature in a claim, e.g., a device comprising a fastener, preferably a screw.

Applicants respectfully submit that one having ordinary skill in the art of email and web browsers, having read the specification, would have no difficulty understanding the invention as recited in the claims, and the Examiner has not demonstrated otherwise.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 102 Rejection

Claims 1-3, 5, 7, 9-11, 13, 15 and 17-20 were rejected under 35 U.S.C. § 102(e) for being allegedly anticipated by U.S. Patent No. 6,859,213 to CARTER. This rejection is respectfully traversed.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must disclose each and every element as set forth in the subject claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that a *prima facie* case of anticipation has not been established as the applied reference fails to teach each and every element of the claims.

More particularly, claim 1 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;
associating the navigation with the email; and
sending the email and the navigation to the recipient.

Additionally, claim 2 recites, *inter alia*,

receiving a web page navigation associated with the email;
passing the web page navigation to a web browser; and
displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed;
wherein the preferred viewing order is included in the navigation.

Furthermore, claim 3 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;
sending the email and the web page navigation to the recipient;
passing the web page navigation to a web browser used by the recipient; and
displaying by the web browser an indication of the preferred viewing order.

Additionally, claim 9 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;
associating the navigation with the email; and
sending the email and the navigation to the recipient.

Moreover, claim 10 recites, *inter alia*,

receiving a web page navigation associated with the email;
passing the web page navigation to a web browser; and
displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed;
wherein the preferred viewing order is included in the web page navigation.

Finally, claim 11 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;
sending the email and the web page navigation to the recipient;
passing the web page navigation to a web browser used by the recipient; and
displaying by the web browser an indication of the preferred viewing order.

CARTER simply does not teach at least these features. Applicants acknowledge that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner explains that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Applicants respectfully disagree. The noted language merely discloses the following:

When the attach button 304 is activated, a dialogue box appears that allows the sender to navigate through a file system and select files to be attached to the e-mail message. Navigation is typically performed using a hierarchical list of file

names. After one or more files are selected, the sender transmits the e-mail message and attached file(s) to a receiver. When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

When a sender wishes to attach HTML documents and other web-based information to an e-mail message, the sender uses the hierarchical list of file names to locate the desired document, or the sender specifies, such as through a text entry mechanism, a URL for each HTML document. Each web page is comprised of one or more separate files in a file system. These files can include, for example, an HTML document and text, graphics and sound files identified by "tags" within the HTML document. Web pages are typically linked to other web pages via embedded URL's. In many cases, dozens of web pages are linked to each other to form a related presentation of data. To send such linked pages using e-mail, each page is attached to an e-mail message for sending to a receiver.

An embodiment of the present invention provides for navigation and browsing of data resources, such as text, graphics and audio source data, when selecting attachments for an e-mail message. These data resources may also include source data containing data written in a markup language (e.g., HTML) that may be rendered by a browsing mechanism, and source data containing links such as embedded resource locators (e.g., URL's or other location references to data resources) that may be used by a browsing mechanism to navigate from one data resource to another. Data resources may contain source data in the form of one or more files, documents, streams and other sources of electronic information, or portions thereof.

By providing the ability to view the contents of prospective attachments before they are attached, a sender is able to confirm that the attachment contains the data expected. Also, via the browsing feature, a sender using an embodiment of the invention has access to advanced search engines on the web to further assist in the location of desired attachments. Advanced search features are not available in e-mail systems of the prior art.

In an embodiment of the invention, linked data resources can be traversed through standard browsing operations in order to locate a desired attachment. This is an advantage over navigation of a hierarchical list of file names, because a hierarchical file list does not provide information regarding possible embedded links to other files that may exist for web pages and other types of compound or linked documents. Further, web links via URL typically have little or no correspondence to particular file system hierarchies and often transcend single

file systems, necessitating, in systems of the prior art, that the sender have knowledge of the particular URL's or the respective file names and directories for the web page or pages that are to be attached to an e-mail message.

FIG. 7 illustrates a method for selecting attachments in accordance with an embodiment of the invention. In step 700, during composition of an e-mail message, when a sender expresses a wish to select an attachment, a graphical user interface (GUI) with browser capability is presented to the sender. If the GUI interface is equipped with an attachment menu, the sender may select the type of the prospective attachment from the menu in step 701. Examples of types of attachment include attachment as a resource locator, such as a URL (universal resource locator), and attachment as source data of the chosen data resource, such as the set of data bits forming a rendered HTML document, or web page. An attachment may be retrieved as all source data of a chosen data resource or a subset thereof.

The Examiner's assertion is simply unsupported by the above-noted disclosure.

In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order defined by the originator.

CARTER is also silent with regard to associating a navigation with the email and/or sending or receiving the email and the navigation (claims 1-3 and 9-11). While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to

view a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position to the contrary. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

As the Examiner should know, retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.

Finally, the Examiner has failed to point to any language whatsoever in CARTER which even remotely discloses that an e-mail sent with a navigation can be passed to a web browser of the receiver of the e-mail (claims 2, 3 and 10).

Thus, Applicants respectfully submit that the above-noted claims are not disclosed, or even suggested, by any proper reading of CARTER.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(e) should be withdrawn.

35 U.S.C. § 103 Rejection

Claims 4, 6, 8, 12, 14 and 16 were rejected under 35 U.S.C. § 103(a) for being allegedly unpatentable over CARTER in view of U.S. Patent No. 6,963,901 to BATES et al. This rejection is respectfully traversed.

Claim 3 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;
sending the email and the web page navigation to the recipient;
passing the web page navigation to a web browser used by the recipient; and
displaying by the web browser an indication of the preferred viewing order.

Furthermore, claim 8 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;
associating the navigation with the email; and
sending the email and the navigation to the recipient.

Additionally, claim 11 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;
sending the email and the web page navigation to the recipient;
passing the web page navigation to a web browser used by the recipient; and
displaying by the web browser an indication of the preferred viewing order.
Additionally, claim 16 recites, *inter alia*,

Finally, claim 16 recites, *inter alia*,

in response to input of the originator, generating a navigation that includes:
a plurality of uniform resource locators that identify web pages to be viewed by the recipient; and
a color associated with each of the uniform resource locators according to a color code, wherein the color code indicates a preferred viewing order in which the web pages are to be viewed by the recipient; and
sending the email and the navigation to the recipient.

The Examiner acknowledges that CARTER lacks, among other things recited in the above-noted claims, the recited preferred viewing order with link colors, icons, and font characteristics. However, the Examiner explains that such features are taught by BATES and that it would have been obvious to combine the teachings of these

documents. Applicants respectfully submit that a *prima facie* case of obviousness has not been established as the applied references fail to teach each and every element of the claims.

As explained above, CARTER is entirely silent with regard to sending or receiving an email includes a navigation having URLs in a viewing order, much less, a preferred viewing order, as recited in at least claims 3, 8, 11 and 16.

Contrary to the Examiner's assertions, BATES does not cure the noted deficiencies of CARTER at least because BATES is also entirely silent with regard to email includes a preferred viewing order as recited in claims 3, 8, 11 and 16. Indeed, while the Examiner has asserted that BATES teaches a browser program having a preference file 244 for navigation web links, the Examiner has failed to point to any language in BATES which discloses or suggests that an email can include a navigation having URLs in a preferred viewing order as recited in claims 3, 8, 11 and 16.

As the Examiner will note, the above-noted claims recite, among other things, the sending of an email and a navigation which includes a preferred viewing order. On the other hand, as noted above, BATES fails to disclose or suggest a preferred viewing order, much less, the sending of an email which includes, among other things, a navigation having URLs in a preferred viewing order.

Applicants note, in particular, that while the system in BATES provides for sending an email with browser information, col. 9, lines 54-59 of BATES explains the following:

The browser information contained in the e-mail message may then be utilized to configure a browser program located on the remote client computer. One

embodiment illustrating a method 800 for receiving and applying browser information by a receiving client computer is shown in FIG. 8.

Thus, BATES discloses a system which allows a user to send an email with browser information which will configure the browser of the recipient. However, this is not the same as sending an email along with a navigation that includes URLs in a preferred viewing order.

Furthermore, as no proper combination of BATES and CARTER discloses or suggests the above-noted features of independent claims 3, 8 and 11, no proper combination of these documents can properly disclose or suggest the features of claims 4, 6, 12 and 14 which respectively depend from these claims, and which further recite features which are not disclosed or suggested by any proper combination of BATES and CARTER.

Thus, Applicants submit that none of the above-noted claims are disclosed or suggested by any proper combination of these documents.

Furthermore, Applicants submit that there is no motivation to combine the above-noted documents at least because BATES fails to cure the deficiencies of CARTER.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Response to the Examiner's Response to Arguments

The Examiner explains on page 11 of the Final Office Action that the indefiniteness rejection of, e.g., claim 1 is proper because Applicants have not explained how the web page navigation is associated with the e-mail. Applicants

disagree. Applicant is not required by Section 112, 2nd paragraph, to explain in the claim how the invention functions. Section 112, 2nd paragraph, only requires that the claims be sufficiently definite to allow one having ordinary skill in the art, having read the specification and using knowledge known in the art to which the invention pertains, to understand which the claim terms mean.

The Examiner also explains on page 11 of the Final Office Action that the indefiniteness rejection of claim 2 is proper because claim 2 has no language indicating that the web page navigation and the e-mail “are attached.” Applicants disagree. Applicants are not required by Section 112, 2nd paragraph, to limit the claim to the subjective desires of the Examiner. Section 112, 2nd paragraph, does not require that recited features be related or “attached”. Again, Section 112, 2nd paragraph, only requires that the claims be sufficiently definite to allow one having ordinary skill in the art, having read the specification and using knowledge known in the art to which the invention pertains, to understand which the claim terms mean.

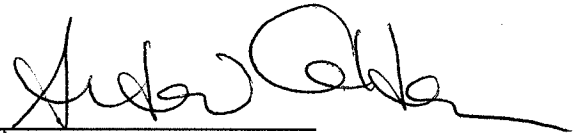
The Examiner explains on page 12 of the Final Office Action that the term “preferred viewing order”, as Applicants have defined it, “has no patentable weight” and “is arbitrary.” There is no basis in patent law for such assertions and the Examiner has not supported such assertions with any citation to patent law or MPEP section.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to

issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Respectfully submitted,
C. L. BATES, *et al.*

A handwritten signature in black ink, appearing to read "Andrew M. Calderon", written over a horizontal line.

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